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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANAND NAGA BABU, ABRAHAM S. HEIFETS, ADAM KRAUSZER, ROY PATERSON, and BRIAN LEE WHITE EAGLE

Appeal 2008-005208
Application 09/773,193
Technology Center 2400

Decided: November 3, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, and LEE E. BARRETT and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 2, 4, 7, 8, 13, 14, 16, 19, 20, 25, 26, and 28. Claims 3, 5, 6, 9-12, 15, 17, 18, 21-24, 27, and 29-36 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The Invention

The disclosed invention relates generally to handling and evaluating location information from multiple sources (Spec. 2).

Independent claim 1 is illustrative:

> 1. A method for handling location information regarding a mobile user having a plurality of associated location sources, said method comprising
>
> simultaneously acquiring items of location data regarding said user from said plurality of location sources;
>
> creating a collection of said location data regarding said user;
>
> determining an expected most accurate location source of said plurality of associated location sources;
>
> ranking items of location data in said collection to define the location of said user according to the expected most accurate location source of said plurality of associated location sources; and
>
> updating said location data continuously with said defined location of said user.

The Reference

The Examiner relies upon the following reference as evidence in support of the rejections:

Dunn	US 5,659,596	Aug. 19, 1997

The Rejections

1. The Examiner rejects claims 1, 2, 4, 7, 8, 13, 14, 16, 19, 20, 25, 26, and 28 under 35 U.S.C. § 102(b) as being anticipated by Dunn.
2. The Examiner rejects claims 1, 7, 13, 19, and 25 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

ISSUE 1

Appellants assert that "Dunn does not disclose . . . multiple location sources or simultaneously acquiring data on location of a mobile user from a plurality of location sources" (App. Br. 13).

Did Appellants demonstrate that the Examiner erred in finding that Dunn discloses a mobile user having a plurality of location sources and acquiring items of location data from the plurality of location sources as recited in claim 1?

ISSUE 2

The Examiner finds that the Specification fails to enable one of ordinary skill in the art to make or use the invention (Ans. 3).

Did Appellants demonstrate that the Examiner erred in finding that the Specification fails to enable one of ordinary skill in the art to make or use the invention?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Dunn discloses an "RSU [remote subscriber unit] 50 . . . [that] may be any mobile communication device which roams" (col. 17, ll. 33-34).
2. Dunn discloses that the "RSU . . . is able to communicate with a home location by establishing a communication with the closest or controlling LSO [local service office]" (col. 17, ll. 8-11).
3. Dunn discloses a "controlling LSO [local service office] . . . receives and stores the RSU . . . and location data in its register" (col. 17, ll. 15-17).

PRINCIPLES OF LAW

35 U.S.C. § 112, first paragraph

Enablement

The first paragraph of 35 U.S.C. § 112 requires, among other things, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without "undue experimentation." *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Whether undue experimentation is required is a conclusion reached by weighing several underlying factual inquiries. *Id.*

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

Issue 1

Claim 1 requires that a mobile user has a plurality of location sources and that location data is acquired from the plurality of location sources. As set forth above, Dunn discloses a mobile device that communicates location information to a local service office (LSO), the LSO storing the location information received from the mobile device (FF 1-3). In contrast to claim 1, the user in Dunn does not possess a plurality of location sources from which the LSO receives location information. Rather, the LSO in Dunn receives location information from a user's mobile device, which constitutes only one device.

The Examiner finds that Dunn discloses "location data acquired from local services offices, which serves as the claimed plurality of location sources where data is acquired from" (Ans. 9). However, Dunn does not disclose that the local service offices (LSO) are possessed by the mobile user (i.e., that a mobile user has a plurality of LSOs). Instead, Dunn merely discloses that a user has a mobile device that roams (FF 1) rather than a

plurality of location devices, much less acquiring location data from a plurality of location devices.

Independent claims 7, 13, 19, and 25 recite similar features as independent claim 1.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claims 1, 7, 13, 19, and 25, and of claims 2, 4, 8, 14, 16, 20, 26, and 28, which depend therefrom, with respect to issue 1.

Issue 2

We disagree with the Examiner that one of ordinary skill in the art would have had to engage in undue experimentation in order to transmit different data simultaneously as opposed to, for example, sequentially.

The Examiner finds that "there is nothing [in the Specification] that suggests that the data is acquired simultaneously" (Ans. 7). However, the Specification discloses that location information is received and that "adapters convert location data from various location sources" (Spec. 9) demonstrating that location data is received from multiple location sources. While the term "simultaneously" (i.e., performed at the same time) is not explicitly disclosed in the Specification, we find that it was well-known to those of ordinary skill in the art to transmit data at various times, including at the same time as transmitting other data. Since transmitting data at the same time as other data was well known in the art, we disagree with the Examiner's implication that an explicit disclosure of "simultaneous" data

transmission (in addition to the disclosure of transmission of data from different sources) would have been required to enable simultaneous transmission of data without undue experimentation. "A patent need not disclose what is well-known in the art." *Wands*, 858 F.2d at 735.

Since transmitting data at the same time as transmitting other data was well-known in the art, we also disagree with the Examiner's finding that "[t]hose of ordinary skill in the art would not know how to acquire the location data simultaneously" (Ans. 7). The Examiner states, "[i]t is possible that data can be acquired so quickly that it may appear . . . that it is being acquired simultaneously . . . [but] is in fact not the case" (*id.*), thereby finding that in some instances it is possible that data may not be transmitted simultaneously with other data. However, the Examiner does not demonstrate that transmitting data simultaneously with other data would in fact have required undue experimentation.

The Examiner further finds that "it would not be predictable for the Appellant to have implied the simultaneous acquiring of data" (Ans. 7-8). We do not find relevance in whether it would or would not have been predictable for Appellants to imply simultaneous acquisition of data. Even assuming the Examiner's finding that it would have been unpredictable for Appellants to imply such acquisition of data, the Examiner has not demonstrated, much less asserted, a level of unpredictability of the art (i.e., the level of unpredictability of the viability of simultaneous data transmission).

The Examiner also finds that "Appellant has provided no direction on how items of location data can be simultaneously acquired" (Ans. 8) and that "[n]o working examples have been provided" (*id.*). However, the Examiner also states that "the data could be acquired almost instantaneously so as to appear simultaneous" (*id.*) demonstrating that, given the state of the prior art and the level of skill in the art, one of ordinary skill in the art could have acquired data "instantaneously so as to appear simultaneous" without undue experimentation. In other words, according to the Examiner, it was already known in the art to acquire data simultaneously.

In view of these findings, since the level of skill of those of ordinary skill in the art (of data transmission) is high with respect to transmitting data, the Examiner has not demonstrated that one of ordinary skill in the art would have needed to resort to undue experimentation to transmit data simultaneously with other data without explicit direction in the Specification of such data transmission. On the contrary, the Examiner explicitly states that it was well known to one of ordinary skill in the art to acquire data instantaneously "to appear to be simultaneous" (Ans. 8). Since, as set forth above, a patent "need not disclose what is well-known in the art" (*Wands*, 858 F.2d at 735) and since acquiring data "to appear to be simultaneous" was known in the art, we disagree with the Examiner that one of ordinary skill in the art would have needed to resort to undue experimentation to practice the art of simultaneous data acquisition.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claims 1, 7, 13, 19, and 25 with respect to issue 2.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have demonstrated that the Examiner erred in finding that Dunn discloses a mobile user having a plurality of location sources and acquiring items of location data from the plurality of location sources (issue 1) and finding that the Specification fails to enable one of ordinary skill in the art to make or use the invention (issue 2).

DECISION

We reverse the Examiner's decisions rejecting claims 1, 2, 4, 7, 8, 13, 14, 16, 19, 20, 25, 26, and 28 under 35 U.S.C. § 102(b) and claims 1, 7, 13, 19, and 25 under 35 U.S.C. § 112, first paragraph.

REVERSED

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